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09/903,606	07/13/2001	Odile Aubrun-Sonneville	210237US0	2212

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER

BERMAN, ALYSIA

ART UNIT

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

<b>Application No.</b> 09/903,606  <b>Examiner</b> Alycia Berman	<b>Applicant(s)</b>	
	<b>Art Unit</b>	
	1617	

-- The MAILING DATE of this communication app ars on th cov r sh et with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1) Responsive to communication(s) filed on 04 November 2002.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

4) Claim(s) 1-13 and 15-39 is/are pending in the application.

4a) Of the above claim(s) 17 and 21 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-13, 15, 16, 18-20 and 22-39 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 14, 2002 has been entered.

Claims 1, 7, 16, 19 and 25 have been amended. Claim 14 has been canceled. Claims 29-39 have been added. Claims 1-13 and 15-39 are pending.

### ***Election/Restrictions***

Claims 17 and 21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 6.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15, 38 and 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 is indefinite because it is dependent on canceled claim 14. Applicant's intent is unclear.

Claims 38 and 39 recite the limitation "active substance". There is insufficient antecedent basis for this limitation in the claim.

Claims 38 and 39 are indefinite because the phrase relating to the concentration range of emulsifier oligomer(s) or polymer(s) is unclear. Does Applicant intend to claim the amount of emulsifier in the composition or the amount of some component of the emulsifier? Further, is the concentration range in relation to some active substance or to the total weight of the composition?

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 39 is rejected under 35 U.S.C. 102(e) as being anticipated by US 5,980,922 (922).

US '922 is directed to personal cleansing articles that contain a water-in-oil emulsion (abstract). The emulsion comprises an oily phase (lipid phase), an aqueous phase containing water and an emulsifier (abstract). The emulsifier is preferably the reaction product of a polyisobutylene-substituted succinic acid and an amine available from Lubrizol® (col. 13, lines 11-22 and 55-57). See column 11, lines 33-38 for the

concentration range of water and aqueous phase. See column 12, lines 30-34 for the concentration range of emulsifier. See also the examples beginning at column 17.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-13, 15-16, 18-20 and 22-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 4,606,913 (913) in combination with the Proceedings of the 5<sup>th</sup> World Surfactants Congress, Volume 2 (Proceedings).

US '913 is directed to high-internal phase emulsions (title and abstract). The emulsions can be water-in-oil (col. 5, lines 28-29). For hydrocarbon oils see column 6, lines 40-51. US '913 discloses at column 6, lines 52-54 that the amount of oil is not critical. Therefore, absent evidence of unexpected results the instantly claimed

concentration range of at least 40 wt.% hydrocarbon oil in the oily phase is not given patentable weight. The amount of oily phase in water-in-oil emulsions is about 2-24% by volume (col. 6, lines 57-68). The amount of aqueous phase in water-in-oil emulsions is usually about 76-98% by volume (col. 7, lines 7-13). Fatty acids and fatty alcohol esters, *inter alia*, are disclosed under the Cosmetic Adjunct Materials bridging columns 17 and 18. The emulsions are made by adding an emulsifier to the oil phase and then adding the aqueous phase to the oil phase (col. 18, line 58 to col. 19, line 4).

US '913 does not teach an emulsifier as instantly claimed. The Proceedings teaches that alkenyl succinic anhydride emulsifiers made with polyisobutylene provide very stable water-in-oil high internal phase emulsions for use in personal care products (abstract, introduction and chemistry). The formula provided under the Chemistry section discloses that R is a hydrocarbon chain having from 12-150 carbons, which encompasses Applicants instantly claimed range of carbon atoms in the polyolefinic apolar component.

It is within the skill in the art to select optimal parameters in a composition in order to achieve a beneficial effect. *In re Boesch*, 205 USPQ 215 (CCPA 198). It would have been obvious for one skilled in the art to vary the proportions of components in a composition to arrive at the best compositions for the intended purpose. "It is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Only if the "results optimizing a variable" are "unexpectedly good" can a patent be obtained for the claimed

critical range. *In re Antonie*, 559 F.2d 618, 620, 195 USPQ 6, 8 (CCPA 1977); see also *In re Dillon*, 919 F.2d 688, 692, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990) (in banc). Therefore, absent evidence of unexpected results, the concentration ranges of components instantly claimed is not given patentable weight.

The limitation of claim 4 regarding the ability of the emulsifier to reduce the interfacial tension between the aqueous and oily phases is an inherent property of the emulsifier. The prior art teaches emulsions containing the same components instantly claimed and the emulsifier instantly claimed. One of ordinary skill in the art would expect the same emulsifier to exhibit the same properties, absent evidence to the contrary. Burden is shifted to Applicant to show that the prior art emulsifier does not exhibit the properties instantly claimed.

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the high internal phase water-in-oil emulsions of US '913 using the polyisobutylene succinic anhydride emulsifier or the Proceedings expecting to obtain excellent stability and a variety of textures of the emulsion.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-16, 18-20 and 22-28 have been considered but are moot in view of the new ground(s) of rejection.

### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alysia Berman whose telephone number is 703-308-

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4638. The examiner can normally be reached Monday through Friday between 9:00 am and 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on 703-305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 or 703-872-9307 for after-final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234 or 703-308-1235.



Alycia Berman  
Patent Examiner  
January 16, 2003



RUSSELL TRAVERS  
PRIMARY EXAMINER  
GROUP 1200